Supreme Court, U.S.
FILED
FEB 24 1988
JOSEPH F. SPANIOL, JR.
CLERK

No. 87-1228

In the Supreme Court
OF THE
United States

OCTOBER TERM, 1987

PENNWALT CORPORATION,
Petitioner,
vs.
DURAND-WAYLAND, INC.,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL COURT

GEORGE M. HOPKINS
TODD DEVEAU
HURT, RICHARDSON, GARNER,
TODD & CADENHEAD
1400 Peachtree Place Tower
999 Peachtree Street, NE
Atlanta, GA 30309-3999
(404) 870-6000

Attorneys for Respondent

28 pp

COUNTERSTATEMENT OF QUESTION PRESENTED

In view of the factual findings in this case and the law applied by the appellate court below, Respondent respectfully submits that there is no basis for review by this Court in this case of the question presented by Petitioner for review. As will be shown below, the appellate court effectively applied the very legal standards that Petitioner claims were not applied. Specifically, the appellate court did not rewrite the doctrine of equivalents, as alleged by Petitioner, but instead correctly applied both the precedent of this Court and its own stare decisis in rendering its decision of November 6, 1987, of which review is sought.

Therefore, the question presented most immediately is:

Whether the United States Court of Appeals for the Federal Circuit has decided a federal question in conflict with the applicable decisions of this Court?

To which the answer is: No, it did not.

STATEMENT OF INTEREST UNDER RULE 28.1

Respondent, Durand-Wayland, Inc., has no parent companies, subsidiaries or affiliates.

TABLE OF CONTENTS

	Page
COUNTERSTATEMENT OF QUESTIONS PRESENTED	i
STATEMENT OF INTEREST UNDER RULE 28.1	ii
TABLE OF CONTENTS	iii
TABLE OF AUTHORITIES	iv
I	
OPINIONS BELOW	1
II	
JURISDICTION	2
III	
CONSTITUTIONAL PROVISION, STATUTES AND RULE INVOLVED	2
IV	
COUNTERSTATEMENT OF THE CASE	3
A. The District Court's Opinion	7
B. The Opinion of the Court of Appeals	9
V	
ARGUMENT — WHY THE PETITION FOR THE WRIT SHOULD BE DENIED	14
CONCLUSION	22

TABLE OF AUTHORITIES

Cases

Page

DMI Inc. v. Deere & Co., 755 F.2d 1570 (Fed. Cir. 1975) 8, 10

Exhibit Supply Co. v. Ace Patents Corp., 315 U.S. 126 (1942) 17, 19

Graham v. John Deere Co., 383 U.S. 1 (1966) 17

Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co., 339 U.S. 605 (1950) 8, 11, 14, 15, 17, 18, 21

Hughes Aircraft Co. v. United States, 717 F.2d 1351 (Fed. Cir. 1983) 18, 20, 21

Palumbo v. Don-Joy Co. 762 F.2d 969 (Fed. Cir. 1985) 10

Perkin-Elmer Corp v. Computervision Corp., 732 F.2d 888 (Fed. Cir. 1984) 11

Radio Steel & Mfg Co. v. MTD Prods Inc., 731 F.2d 840 (Fed. Cir. 1984) 10

Sargent v. Hall Safe Co., 114 U.S. 63 (1885) 19

Statutes

28 U.S.C. §1254(1) 2

28 U.S.C. § 1292(c) 9

28 U.S.C. § 1295(a) 9

35 U.S.C. § 112 ..... 9, 10, 15, 16

Rules

Sup. Ct. R. 17.1 ..... 2, 3

Fed. R. Civ. P. 52(a) 10, 16

No. 87-1228

In the Supreme Court
OF THE
United States

OCTOBER TERM, 1987

PENNWALT CORPORATION,
Petitioner,
vs.
DURAND-WAYLAND, INC.,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL COURT

Respondent respectfully requests that the Petition for a Writ of Certiorari to review the judgment and opinion of the United States Court of Appeals for the Federal Circuit in this case be denied.

I.
OPINIONS BELOW

The opinions below are as reproduced in Appendix 1 to the Petition; however, they are mischaracterized in the Petition with portions of the opinions taken out of context as will be explained below.

II.

JURISDICTION

The jurisdictional requisites for filing the Petition are adequately stated in the Petition, namely 28 U.S.C. § 1254(1); however, there is no valid reason for review as provided by Supreme Court Rule 17.1, and particularly, Rule 17.1(c).

III.

CONSTITUTIONAL PROVISION, STATUTES AND RULE INVOLVED

In addition to the Constitutional Provision and statutes presented in the Petition which Petitioner indicates are involved, Supreme Court Rule 17.1 is also involved.

SUPREME COURT RULES

Rule 17. Considerations Governing Review on Certiorari

.1. A review on writ of certiorari is not a matter of right, but of judicial discretion, and will be granted only when there are special and important reasons therefor. The following, while neither controlling nor fully measuring the Court's discretion, indicate the character of reasons that will be considered.

• • •

(c) When a state court or a federal court of appeals has decided an important question of federal law which has not been, but should be, settled by this Court, or has decided a federal question in a way in conflict with applicable decisions of this Court.

Rule 17 of the Rules of this Court lists three primary reasons why this Court would consider a review on a writ of certiorari. None of these reasons applies to the present case: (1) There is no conflict of a decision between one federal court of appeals and another federal court of appeals; (2) There is no decision of a state court of last resort deciding a Federal issue in a way in conflict with a decision of another state court of last resort or of a federal court of appeals; and (3) there is no state court or federal court of appeals which has decided an important question of federal law which has not been, but should be, settled by this Court. Indeed, the Petitioner herein does not contend that any one of these reasons exist.

IV.

COUNTERSTATEMENT OF THE CASE

This is a civil action for patent infringement initiated by Petitioner on September 26, 1980 in the United States District Court for the Northern District of Georgia alleging infringement of claims 1, 2, 10 and 18 of U.S Patent No. 4,106,628 (the '628 patent). Claims 1 and 10 are representative of the alleged claims and read, as follows:

> 1. An automatic sorting apparatus comprising conveyance means for transporting a plurality of items to be sorted along a track and having individual cups for transporting each said item, said individual cups being connected in a continuous belt;
>
> electronic weighing means incorporated into a portion of said track for generating a signal proportional to the weight of said item to be sorted,
>
> reference signal means for providing a predetermined number of reference signals, the value of each

signal established according to a predetermined criteria,

comparison means for comparing the signal generated by said electronic weighing means to the reference signals provided by said reference signal means,

clock means for incrementally signalling changes in position of an item to be sorted,

first position indicating means responsive to the signal from said clock means and the signal from said comparison means for generating a signal indictive of the position of the item to be sorted, and

discharge means responsive to the signal generated by said position indicating means for discharging the item to be sorted at a predetermined position.

10. An automatic sorting apparatus comprising electronic weighing means for generating a signal proportional to the weight of an item to be sorted;

first reference signal means for providing a predetermined number of reference signals, the value of each signal being established according to a predetermined criteria,

first comparison means for comparing the signal generated by said electronic weighing means to the reference signals provided by said first reference signal means,

optical detection means for generating a signal proportional to the color of an item to be sorted,

second reference signal means for providing a predetermined number of reference signals, the value of each signal being established according to a predetermined criteria,

second comparison means for comparing the signal generated by said optical detection means to the reference signals provided by said second reference signals means, and generating a signal therefrom,

clock means for incrementally signaling changes in the position of the item to be sorted,

first position indicating means responsive to a signal from said clock means and said signal from said second comparison means for continuously indicating the position of an item to be sorted while the item is in transit between said optical detection means and said electronic weighing means,

second position indicating means responsive to the signal from said clock means, the signal from said first comparison means and said first position indicating means for generating a signal continuously indicative of the position of an item to be sorted after said item has been weighed, and

discharge means responsive to the signal from said second position indicating means for discharging the item at a predetermined one of a plurality of sorting positions.

With reference to the above claims, it is seen that the invention described by the claims (*i.e.*, the *claimed* invention) in the '628 patent is "An automatic sorting apparatus". The claims make no reference to a high speed automatic machine for electronically sorting articles as described by Petitioner. (Pet. 3).[1] Claim 1 is directed to an apparatus which sorts items by weight. Claim 2 is a dependent claim, dependent upon Claim 1, and therefore

[1]References are to the "Petition for a Writ of Certiorari" (Pet. _____) and the Appendix thereto (A-_____).

includes all of the features of Claim 1. Claims 10 and 18 are directed to a sorting apparatus which sorts items by weight or by color or both. Thus, Claims 10 and 18 include the same features recited in Claim 1, plus the additional features relating to color sorting capability. The sorting apparatus recited in Claims 10 and 18 include "optical detection means for generating a signal *proportional* to the color of an item to be sorted", not *representative* of the color as petitioner describes. The claimed apparatus of Claims 1 and 10 includes "electronic weighing means for generating a signal *proportional* to the weight of said item to be sorted", and not *representative* of the weight as petitioner describes. (Pet. 3).

In the prosecution of the patent-in-suit, Claims 1, 2, 10 and 18 were repeatedly rejected by the Patent and Trademark Office and only allowed after the "position indicating means" was added to all the claims and only after the term "continuously" was added in two places to both Claims 10 and 18. The adding of these terms in the claims was to distinguish the subject matter of the '628 patent over the sorters disclosed in the prior art patents cited by the Patent and Trademark Office and has created a classic example of "prosecution history (file wrapper) estoppel". Furthermore, Petitioner's description of the Durand-Wayland machines is in disagreement with the findings of fact of the district court in numerous ways, including the court's finding that the accused machines do not perform substantially the same function in substantially the same way, to obtain the same results.

Petitioner comments that the district court found the machine described in the patent-in-suit and the accused machine are virtually identical *except* for the control system that conducts the sorting operation. (Pet. 4). Yet, it is that very control system which is the heart of the

invention described by the claims of the '628 patent and to which the court appointed expert was referring, when he stated that the components and method used by the patent-in-suit and the accused devices differed significantly. (A-10, 11)

A. The District Court's Opinion

After a lengthy trial, the district court took the case under advisement, subsequently rendering its Order (A-90) and supplemental Order (A-126) found in Petitioner's Appendix 1. With regard to its finding of fact of non-infringement, the district court made a number of underlying findings of fact, including the facts that the following elements, as recited in Claim 1, are not literally found in Durand-Wayland's accused sorting devices:

> 1. The "electronic weighing means for generating a signal proportional to the weight of an item to be sorted";[2]
>
> 2. The "comparison means for comparing the signal generated by said electronic weighing means";[3]
>
> 3. The "first position indicating means responsive to the signal from said clock means and the signal from said comparison means for generating a signal indicative of the position of the item to be sorted".[4]

---

[2]Specifically, the district court found: "The signal that is generated by the 'Microsizer' [the Durand-Wayland device] is not proportional (and cannot be made proportional by mathematical computation) to the weight of the fruit." (A-117).

[3]The district court specifically found: "Thus, the 'Microsizer' does not literally compare signals as described in the patent-in-suit . . ." (A-117).

[4]The district court specifically found: "Thus, the 'Microsizer' has neither a 'first position indicating means' nor a 'second position

These same three (3) features are also recited in Claims 10 and 18 and were likewise held not literally found in the accused sorting devices. In addition, the district court found that the accused devices do not literally include an "optical detection means for generating a signal proportional to the color of an item to be sorted", as recited in Claims 10 and 18.[5] The Court thus concluded that all of the elements of the claims in issue are not present in the Durand-Wayland machines. (A-116).

The district court next considered infringement under the doctrine of equivalents pursuant to this Court's decision in *Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co.*, 339 U.S. 605 (1950). It first determined the range of equivalents which it felt the claimed invention was entitled, in accordance with the procedure outlined by the Court of Appeals for the Federal Circuit in *DMI, Inc. v. Deere & Co.*, 755 F.2d 1570, 1575 (Fed. Cir. 1975). The patent-in-suit was found not to be a pioneer patent. (A-119). The court concluded "that the 'means' for claims of the patent-in-suit are not limited to 'hard-wired' components [such as are disclosed in the patent] and can be read to include microprocessing computers that are the legal equivalents of the disclosed 'hard-wired' components" (A-121), but that the claims "should be read in

---

indicating means'. The machine described in the patent-in-suit produces signals that indicate where the fruit is, i.e., track the progression of each cup. The "Microsizer" does not." (A-118).

[5]The district court specifically found: The 'Microsizer' (with a 'Microsorter' apparatus) operates on the amount of light that reflects off of a piece of fruit, and the microprocessor software applies mathematical calculations to the digitized color data in order to sort according to color. The 'Microsizer' does not provide a signal which is proportional to the color of a piece of fruit." (A-118).

light of the careful phraseology chosen by the inventors" (A-119).

The district court then went on to find: The "Microsizer" does not employ substantially the same means as the patent-in-suit, nor does the "Microsizer" function in substantially the same way.[6] (A-118). The court concluded "that the differences in the Durand-Wayland's machines are substantial and significant enough to escape a charge of infringement by Pennwalt." (A-125).

Thus, the trial court did not merely reapply the analysis for literal infringement of "means for" claims under 35 U.S.C. § 112, ¶ 6. Furthermore, the court's findings are contrary to petitioner's assertion that both the invention and the accused machines perform substantially the same function in substantially the same way to obtain the same result. (Pet. 4).

Judgment of non-infringement in favor of respondent, Durand-Wayland, Inc. was entered on December 28, 1984. Petitioner took appeal to the Court of Appeals for the Federal Circuit pursuant to 28 U.S.C. § 1292(c) and § 1295(a).

B. The Opinion of the Court of Appeals

The Court of Appeals for the Federal Circuit affirmed the judgment of noninfringement, stating:

> "The district court found that Durand-Wayland's accused devices do not infringe any claim, literally or

---

[6]This finding is clearly indicated as the heading of the subsection of the decision in which the doctrine of equivalents was considered. The district court concluded that "the 'Microsizer' functions in a substantially different manner than does the machine disclosed in the patent-in-suit." (A-123).

> under the doctrine of equivalents. Unable to view that finding as clearly erroneous under Fed. R. Civ. P. 52(a), we affirm the judgment of noninfringement and vacate, as moot, that part of the judgment concerning the validity of Pennwalt's patent." (A-3).[7]

The Federal Circuit first interpreted the claims of the patent in issue as describing the elements or features of the claimed invention in the form of "means-plus-function" language pursuant to 35 U.S.C. § 112, paragraph 6. The court of appeals went on to state:

> The statute [§ 112, ¶ 6] means exactly what it says: To determine whether a claim limitation is met literally, where expressed as a means for performing a stated function, the court must compare the accused structure *with the disclosed structure*, and must find equivalent *structure* as well as *identity* of claimed *function* for that structure.
>
> *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 975, 226 U.S.P.Q. 5, 8 (Fed. Cir. 1985); *D.M.I., Inc. v. Deere & Co.*, 755 F.2d 1570, 1575, 225 U.S.P.Q. 236, 239 (Fed. Cir. 1985); *Radio Steel & Mfg. Co. v. MTD Prods., Inc.*, 731 F.2d 840, 848, 221 U.S.P.Q. 657, 663 (Fed. Cir. 1984). (A-6).

It then found no literal infringement, on the basis, for example, that respondent's accused devices did not literally perform the same function specified in the asserted claims for the "position indicating means" element found in the claims. (A-6, 7).

---

[7]The ruling that the issue of the validity of the '628 patent is moot is the basis of Respondent's Cross-Petition for a Writ of Certiorari filed concurrently with this Brief.

The court of appeals next went on to consider infringement under the doctrine of equivalents, stating:

> Under the doctrine of equivalents, infringement *may* be found (but not necessarily) if an accused device performs substantially the same overall function or work, in substantially the same way, to obtain substantially the same overall result as the claimed invention. *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 901-02, 221 U.S.P.Q. 669, 679 (Fed. Cir.), *cert denied*, 469 U.S. 857 (1984); *Graver Tank*, 339 U.S. at 608. That formulation, however, does not mean one can ignore claim limitations. (Emphasis by court). (A-7).

Consideration was given to the scope of equivalency to which the claims of the '628 patent were entitled. The court noted that the doctrine will not extend to (1) cover what is found in the prior art, and (2) certain coverage given up during the prosecution of the application for the patent. (A-7, n.1).

The court of appeals concluded:

> "With respect to the scope of equivalent functions, the [district] court correctly limited the claims, based upon *review of the prosecution history*, stating that 'the claims of the patent should be read in the light of the careful phraseology [of functions] chosen by the inventors' because 'the machine disclosed in the patent dispute was carefully described so that it did not read on the prior art.' " (Emphasis added) (A-11).

The appellant court also stated: "the invention was not a pioneer, but an improvement in a crowded art" (A-14) and "the claims are 'broad' with respect to what type of product can be sorted" but "*narrow*, however, with the

respect to how the claim sorter operates." (Emphasis added) (A-11, 12).

In interpreting the "prosecution file history" of the patent-in-suit, the appellate court noted that the district court's appointed expert, Dr. Vacroux, was "not concerned, for example, with the scope of equivalents to which the claims were entitled in view of the *prosecution history*." (A-10). It then devoted itself to an analysis of the prosecution history of the application for the '628 patent, stating:

> "Originally the claims [1, 2, 10 and 18] contained no position indicating means element with its associated functional limitations. The addition of that element was crucial to patentability." (A-12).

The appellate court then specifically approved the trial court's finding of fact that:

> "The accused devices do not have any position indicating means to determine positions of items to be sorted." (A-12).

The appellate court also approved the district court's finding of fact that the memory function of Durand-Wayland's accused devices is not the same or substantially the same as the function of "continuously indicating" where an item is physically located in a sorter. (A-14). The Court, applying the doctrine of "prosecution history (file wrapper) estoppel", concluded:

> "On this point the record is indisputable that before the words "continuously indicating" were added as an additional limitation, the claim was unpatentable in view of the *prior art* which, like the accused machines, sorted the information with respect to sorting criteria in memories but did not

'continuously' track the location." (emphasis by court) (A-14).

Thus, the court of appeals concluded that having secured claims only by including very specific *functional* limitations, Pennwalt could not avoid those very limitations under the doctrine of equivalents. (A-14, 15). The court of appeals further concluded that "no component in the Durand-Wayland device performed a function within the permissable range of equivalents for the function of the first position indicating means . . . No means with an equivalent function was substituted in the accused devices and thus there can be no infringement under the doctrine of equivalents." (A-15).

The court of appeals further found that:

> While a microprocessor theoretically could be programmed to perform that function, the evidence led the court to a finding that the Durand-Wayland machines performed a *substantially different* function from that which each of the claims requires. (A-13).

That finding was based at least in part on the opinion of the district court's expert that the "components and methods used [by the patent-in-suit and the accused devices] *differed significantly*." (A-11).

In the Petition, there is no dispute that Claims 1, 2, 10 and 18 are not literally infringed. Nor is any issue raised

concerning the findings of fact below. The issue presented by Petitioner is whether the doctrine of equivalents was properly applied.

V.

ARGUMENT

WHY THE PETITION FOR THE WRIT SHOULD BE DENIED

It is the position of Respondent that not only are the findings of fact of the district court as affirmed by the court of appeals correct as to equivalency, as a matter of law the court of appeals was correct in its application of the doctrine of equivalents.

Both the district court and the court of appeals applied this Court's decision of *Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co.*, 339 U.S. 605 (1950), in determining whether the claims of the '628 patent were infringed. Contrary to the assertion of Petitioner, the appellate court did not overrule any previous case on the doctrine of equivalents. Instead it made a very narrow decision that the findings of fact of the district court were not clearly erroneous.

The question presented by Petitioner for review appears to be two fold:

> (1) Does a finding that a patent claim is not literally infringed foreclose as a matter of law a finding of infringement under the doctrine of equivalents; or
>
> (2) must the doctrine [of equivalents] still be applied by comparing the accused device to the claimed invention as a whole.

The two above questions simply do not exist in the judgment of which review is sought. Neither court below came to the conclusion that finding a claim was not literally infringed foreclosed as a matter of law a finding of infringement under the doctrine of equivalents; nor did either court below refuse to apply the doctrine of equivalents "by comparing the accused device to the invention as a whole."

Petitioner contends that the courts below misapplied § 112, ¶ 6, in determining the noninfringement of the claims, and in doing so failed to apply the doctrine of equivalents according to the *Graver Tank* decision. That simply is not true. As seen from the analysis of the lower courts' opinions given above, both courts properly applied the two step process of *Graver Tank* in finding that the claims were not infringed.[8] They both first determined the claims were not literally infringed. (A-116, 5). Then they both went on to consider the permissable scope of equivalents to which the claims should be entitled under the circumstances of this particular case. Next, they both applied the test of equivalency under *Graver Tank*, namely, does the invention as defined by the claims of the patent and the accused devices perform "substantially the same function in substantially the same way to obtain the same result." 339 U.S. at 608. The district court concluded that the claims were not infringed under the doctrine of equivalents. (A-118). The court of appeals

---

[8]The *Graver Tank* decision provides: "In determining whether an accused device or composition infringes a valid patent, resort must be had in the first instance to the words of the claim. If the accused matter falls clearly within the claim, infringement is made out and that is the end of it." 339 U.S. at 607. If not, the doctrine of equivalents is to be considered, but may not always be applied. *Id.* at 608.

found that the district court's conclusion was not clearly erroneous under Rule 52(a), Fed. R. Civ. P. (A-3). Thus, the first part of Petitioner's question for review is not present in this case.

The second part of Petitioner's question for review is not present either. The entire thrust of the Petitioner's argument is:

> "The majority opinion rejects *Graver Tank* and makes equivalence the prisoner of a rigid formula by requiring obvious and exact equivalents for every element of a claim, i.e., it abrogates the 'as a whole' analysis of the Doctrine of Equivalents implicit in *Graver Tank* * * * (Pet. 11).

This too is simply not correct. Clearly, the decision of the court of appeals does not abrogate the doctrine of equivalents. The far greater portion of the opinion of the court of appeals addresses the doctrine of equivalents. (A-7, *et seq.*). In this, the court compared the accused devices to the claimed invention, *as a whole*, concluding that the invention of the patent-in-suit was a "non-pioneer" invention, but that it was entitled to some range of equivalents. It further pointed out that, in applying the doctrine of equivalents, "each limitation must be viewed *in the context of the entire claim.*" (A-7).

The appellate court pointed out that the district court examined the claims under § 112, paragraph 6, but that the district court did not limit its infringement analysis to literal infringement under § 112, and found that the district court was not "clearly erroneous" in its finding of fact that every single function required by the claims or an equivalent function was not performed by the Durand-Wayland sorter. Indeed, the appeals court quoted the findings of the court appointed expert, Dr. Vacroux, to

the effect that the components and methods used by the patent-in-suit and the accused devices differed significantly. (A-11).

Petitioner's argument is further fatally flawed. It completely ignores the finding of prosecution history (or file wrapper) estoppel by the courts below and its application to limit the scope of equivalency to which the claims of the patent are entitled. Petitioner seeks to have this Court erase meaningful functional limitations that it added to the claims during the prosecution of the application for the patent, in order to get the application allowed over previous sorting devices disclosed in prior art patents cited by the U.S. Patent and Trademark Office against the application. This it cannot do. In *Graver Tank*, this Court stated:

> What constitutes equivalency must be determined against the context of the patent, the prior art and the particular circumstances of the case. *Id.* at 609.

The court of appeals applied the well settled doctrine of file wrapper estoppel, citing to this Court's decisions in *Graham v. John Deere Co.*, 383 U.S. 1, 33-34 (1966), and *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 136 (1942), in finding that there was no equivalence under the doctrine. (A-17).

"A finding of equivalence is a determination of fact." *Graver Tank*, 339 U.S. at 609. The determination of the district court should not be disturbed, unless clearly erroneous. As this Court further stated in *Graver Tank*:

> "It is not for this court to even essay an independent evaluation of this evidence. This is the function of the trial court. And, as we have heretofore observed, 'To no type of case is this *** more appropriately applicable than to the one before us, where the

> evidence is largely the testimony of experts as to which the trial court may be enlightened by scientific demonstrations." *Id.* at 611.

In the present case, the trial took several weeks, as did the trial in *Graver Tank*. The trial court even viewed motion pictures (i.e., video tapes) as the court did in *Graver Tank*. The difference, of course, is that, in *Graver Tank*, the trial court found that there was equivalency, holding that the patented composition had essentially a "combination of alkali earth metal silicate and calcium fluoride", whereas the accused composition contained "silicates of calcium and magnesium, the two alkali earth metal silicates". The court, in *Graver Tank*, was very careful, however, not to disturb the findings of fact of the trial court.

Graver Tank is directly in point for the respondent in that it did not require an overall equivalency with respect to the claim "as a whole" as claimed by the petitioner's Brief. Those chemicals found equivalent were elements in the claim.

The Petitioner relies upon the Federal Circuit case of *Hughes Aircraft Co. v. United States*, 717 F.2d 1351, 1361 (Fed. Cir. 1983), citing the fact that the Federal Circuit in the *Hughes* case reversed a district court's decision because of the failure to consider the invention as a whole. In the present case, the equivalency of each element of the claims was fully considered and it was determined under the doctrine of prosecution history estoppel that there could be no equivalency.

As pointed out above, the district court and the court of appeals in concluding that there was no infringement of the patent-in-suit by the accused structures, considered the file history or file wrapper of the patent-in-suit and

determined that the claims were narrowed in order to obtain allowance and that they cannot now be construed as if those limitations did not appear.

In *Sargent v. Hall Safe Co.*, 114 U.S. 63, 86 (1885), this Court held that any limitation imposed by the inventor, especially after the application has been persistently rejected, "must be strictly construed against the inventor and in favor of the public, and looked upon in the nature of disclaimers."

In the leading case of *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126 (1942), (which was relied upon by the appeals court (A-15)) the plaintiff's patent disclosed a switch for a pinball machine that closed an electric circuit when a target was hit by a ball. Claim 4 of the patent covered three basic elements: a standard anchored in the table, a coil spring surrounding the standard, and conductor means "embedded in the table". The drawing illustrated a conductor in the form of a ring set in the table with its flange projecting slightly above the surface of the table. A leg pending from the coil spring would make contact with a conductor at a point near or below the surface of the table. Claim 7 which recited the conductor means "carried by the table" was rejected on art and subsequently amended by substituting "embedded in the table" for "carried by the table".

In the *Exhibit Supply*, the plaintiff conceded that there was no literal infringement and the defendant conceded that the devices were the mechanical equivalent of the conductor means embedded in the table. This Court declined to pass on the doctrine of equivalents, holding it inapplicable where the patent owner was seeking to recover surrendered subject matter, stating:

> Whatever may be the appropriate scope and application of the doctrine of equivalents, where a claim is allowed without a restrictive amendment, it has long been settled that recourse may not be had to that doctrine to recapture claims which the patentee has surrendered by amendment.
>
> Assuming that the patentee would have been entitled to equivalents embracing the accused devices had he originally claimed a "conductor means embedded in the table", a very different issue is presented when the applicant in order to meet objections in the Patent Office, based on references to the prior art, adopted the phrase as a substitute for the broader one "carried by the table". *Id.* at 136.

It is respectfully submitted that the court below was simply following this Court's decision in *Exhibit Supply Co.* in applying the doctrine of prosecution history estoppel (file wrapper estoppel) to preclude a broad interpretation to "position indicating means" and to "continuously tracking" in the claims. Both were introduced by amendment to distinguish over the prior art and acquiesed in by the applicant.

The appellate court rightly recognized that "Pennwalt now seeks to avoid those very limitations under the doctrine of equivalents." (A-15).

The decision in *Hughes Aircraft Co. v. United States*, 717 F.2d 1351 (Fed. Cir. 1983), relied on so heavily by Petitioner, is not at all in dispute with the general doctrine of prosecution history estoppel (file wrapper estoppel) and, indeed, endorses the doctrine on which the court below relied stating:

> The doctrine of prosecution history estoppel precludes a patent owner from obtaining a claim con-

> struction that would resurrect subject matter surrendered during prosecution of his application. The estoppel applies to claim amendment to overcome rejections based on prior art. *Id.* at 1362.

The reason the district court in *Hughes* was reversed was that it applied a requirement for two elements that there be "obvious and exact" equivalents in the accused structure for there to be infringement. *Id.* at 1364. The court below has not applied an "obvious and exact" test for equivalency.

The Federal Circuit in *Hughes*, unlike here, found that the amendments made to the claims in the patent in that suit were not related to the very features in the claims upon which the patentee was claiming equivalency. *Id.* at 1363. Furthermore, the court in *Hughes*, in applying the doctrine of equivalents reviewed the specific elements of the claims in question on an element by element basis. *Id.* at 1364-66. Therefore, the Federal Circuit opinion below in this case is completely in accord with its opinion in Hughes.

Lastly, the gist of the opinion of noninfringement is that if an element recited in the claim of the patent is not literally found in the accused devices and no substitute element is found in the place of the missing element within the permissible scope of equivalents under *Graver Tank*, then there can be no infringement, for the accused device is then lacking one of the elements of the claim. This is the basis of the additional opinion by Judge Nies which opinion cites a long history of cases by this Court supporting such a view. (A-36).

CONCLUSION

To apply the reasoning of the Petitioner, Pennwalt, to the decision of the court of appeals would, in effect, render moot the doctrine of prosecution history estoppel (file wrapper estoppel) as decided by this Court. Thus, respondent respectfully requests that the Petition be denied.

Respectfully submitted,

GEORGE M. HOPKINS
TODD DEVEAU
HURT, RICHARDSON, GARNER,
TODD & CADENHEAD
1400 Peachtree Place Tower
999 Peachtree Street, NE
Atlanta, GA 30309-3999

Attorneys for Respondent

CERTIFICATE OF SERVICE

I, George M. Hopkins, a member of the Bar of the Supreme Court of the United States and counsel of record for Durand-Wayland, Inc., respondent herein, hereby certify that on _____, 1988, pursuant to Rule 28, Rules of the Supreme Court, I have served three (3) copies of the attached Brief for Respondent in Opposition to Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Court on Pennwalt Corporation, Petitioner herein, by depositing such copies of the United States Post Office, Atlanta, Georgia, with first class postage prepaid, properly addressed to the post office address of Joel S. Goldhammer, Esquire, the above-named petitioner's counsel, at Siedel, Gonda, Goldhammer & Abbott, P.C., 1800 Two Penn Center Plaza, Philadelphia, Pennsylvania, 19102.

All parties required to be served have been served.

Dated: _____

GEORGE M. HOPKINS
HURT, RICHARDSON, GARNER,
TODD & CADENHEAD
1400 Peachtree Place Tower
999 Peachtree Street, NE
Atlanta, Georgia 30309-3999
(404) 870-6450